

PATENT

Serial No. 09/158,549

Att. Dkt. No. SEDN/5515

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed February 27, 2006. In the Office Action, the Examiner notes that claims 1, 2, 4-6, 16, 17, 19-21, and 43-45 are pending and rejected. By this response the claims continue unamended.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Further, all of the claims now pending in the application satisfy the requirements of 35 U.S.C. §112.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

35 U.S.C. §112 Rejection of Claims 1 and 16

The Examiner has rejected claims 1 and 16 under 35 U.S.C. §112, ¶1, as failing to comply with the written description and the enablement requirements. Applicants' respectfully traverse the Examiner's rejection.

Claim 1 recites the following:

"A hardware upgrade for enhancing the functionality of a set top terminal in a television program delivery system, each set top terminal adapted to receive electronic mail and having a microprocessor, the hardware upgrade comprising:
an interface for providing an electrical connection to the set top terminal, whereby digital data, including the electronic mail, is transferred from the set top terminal for processing and the processed electronic mail is passed to the set top terminal for display; and
at least one microprocessor connected to said interface for processing the electronic mail to produce processed electronic mail, the microprocessor of the hardware upgrade capable of communicating with the microprocessor of the set top converter through the interface."

In the prior office action response Applicants identified a portion of the ultimate priority document specification related to electronic mail. However, in the present office action the examiner contends the identified portion provides insufficient support to be

444213-2

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/5515

entitled to the benefit of the priority document filing date. More particularly, the examiner contends that "even if the phrase of page 26, lines 5-7 could be construed to read that the 'interactive features', including electronic mail are accessed using the interactive service level B menu and because of the upgrade level B interactive unit, that written description still does not explicitly state that the upgrade level B interactive unit receives and processes electronic mail and passes the instant electronic mail back to the set top terminal for display."

Applicants respectfully direct the examiner's attention to pages 112-114 of 07/991,074, where an "example of a submenu for level B interactive services" is shown and described with respect to figure 53. It is specifically noted on page 112 (first full paragraph) that the interactive services depicted in figure 53A are Level B Interactive services.

Specifically, figure 53A depicts exemplary interactive services; namely, Prodigy, America Online, X*Press, airline reservations, hotel reservations, encyclopedia, shopping Center, games, at list, Associated Press, US Yellow Pages and Cable Faxmail. It is well known that at least the Prodigy and America Online interactive services include e-mail services (and included such services prior to the filing of the ultimate priority document herein). Thus, it is clear that the disclosure of the ultimate priority document contemplates interactive services including electronic mail services. Moreover, such interactive services are implemented and processed via the level B upgrade.

Figures 53B-53I provide an example of a sequence of menus that a subscriber may encounter with a non-line data service, illustratively the airline information and reservations data service. The functionality described with respect to the airline information and reservations interactive service is substantially the same as the functionality associated with the other interactive services. Thus, processing for this service is exemplary of processing for all the services.

In general, the airline information and reservations interactive service provides for user interaction at a set-top terminal in which the set-top terminal processes user requests and server responses to provide thereby the desired interactive service and related display imagery. Similarly, electronic mail services offered by the Prodigy and

444213-2

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/5515

America online services are implemented at the set-top terminal such that, for example, electronic mail is received and processed by the set-top terminal. Thus, it is respectfully submitted that the claimed "receives and processes electronic mail and passes the instant electronic mail back to the set-top terminal for display" is fully supported by the specification of 07/991,074.

The present application is a divisional of U.S. Patent No. 5,990,927 (Application No. 08/160,194), filed December 2, 1993, which is a continuation-in-part of U.S. Patent Application No. 07/991,074, filed December 9, 1992. As discussed above, the limitations of claim 1 are fully supported by the disclosure of the 07/991,074 parent application, and thus have a priority date of December 9, 1992. Since claim 16 has relevant limitations similar to those of claim 1, in respect they submitted that the limitations of claim 16 also are fully supported by the disclosure of the 07/991,074 parent application, and thus have a priority date of December 9, 1992.

35 U.S.C. §103 Rejection of Claims 1-2, 4-6, 16-17, 19-21 and 43-45

The Examiner has rejected claims 1-6, 16-21 and 41-44 under 35 U.S.C. §103(a) as being unpatentable over Kauffman (U.S. Patent No. 5,003,591, hereinafter "Kauffman"), in view of Handelman (U.S. Patent No. 5,715,315, hereinafter "Handelman") and Lett (U.S. Patent No. 5,657,414, hereinafter "Lett"). Applicants respectfully traverse the rejection.

In view of the above discussion with respect to the support for claims 1 and 16 in the ultimate priority document, the Handelman reference (having a priority date of September 15, 1993) is not prior art against claim 1 because this reference has a priority date after the priority date of claim 1. Thus, since the Handelman reference is a critical portion of the rejection of claims 1-6, 16-21 and 41-44 under 35 U.S.C. §103(a), it is respectfully submitted that this rejection is now moot.

In addition, the Kauffman and Lett references, either singly or in any allowable combination, fail to disclose or suggest the claimed invention.

Kauffman provides a system in which the cable television converter is remotely modifiable via a firmware upgrade, the firmware integrity having been verified prior to execution of new converter functions.

444213-2

Page 8 of 11

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/5515

Lett provides an auxiliary device control for a subscriber terminal comprising a bidirectional communication and data interface between the subscriber terminal and one or more auxiliary devices, such as a video cassette recorder. For example, Lett discloses that:

"The expansion card 138 is a printed circuit card which contains memory and/or secure microprocessor components, which can be plugged into a connector 200. The connector 200 electrically extends the control microprocessor memory bus 141 and the secure microprocessor bus 143 to the expansion card 138. Additional program or data memory, or renewed security can be provided by the expansion card 138." (column 8, lines 55-62)

However, the Lett reference does not disclose that the expansion card microprocessor is for processing electronic mail.

Thus, in addition to the teachings relied upon by the examiner with respect to Handelman, the Kauffman and Lett references also fail to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 16 and 45 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 16 and 45 also are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 4-6, 17, 19-21 and 43-44 depend, either directly or indirectly, from independent claims 1 and 16 and recite additional limitations thereof. As such, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

444213-2

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/5515

THIS PAGE LEFT BLANK

PATENT

Serial No. 09/158,549

Atty. Dkt. No. SEDN/9515

CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. §103. Further, all of the claims now pending in the application satisfy the requirements of 35 U.S.C. §112. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 5/30/06

E J Wall
Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808